



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,955	07/25/2000	Kazuyuki Murata	10873.108USD3	7440

7590 07/29/2004
Merchant & Gould P C
P O Box 2903
Minneapolis, MN 55402-0903

EXAMINER

LAMB, TWYLER MARIE

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 07/29/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/624,955

Applicant(s)

MURATA, KAZUYUKI

Examiner

Twyler M. Lamb

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/719,796, filed on 9/25/1996.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 31, 32, 33, 35, 39, 40, 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakata et al. (Sakata) (US 5,105,284).

With regard to claims 31 and 39, Sakata discloses a printer (Figure 1, digital copier) comprising: means (col 5, line 7 – col 6, line 65) for printing an image according to image data; means (memory card reader V) for retrieving print control data and image data stored in a removable storage medium (laser card 220) when the medium is connected to the means for retrieving (col 20, line 50 – col 22, line 35); means for setting an operation condition of said printing means according to the output control data (col 20, line 50 – col 22, line 35); and means for controlling the printing means according to the operation condition so that the printing means can print an image according to the image data (col 20, line 50 – col 22, line 35).

With regard to claims 32 and 40, Sakata also discloses wherein the removable storage medium is a memory card (laser card; col 12, lines 3-33).

With regard to claim 33, Sakata discloses a digital copier wherein compressed image data is stored in the removable storage medium (col 10, lines 6-36) and the printer further comprises means (DMAC) for expanding the compressed image data read out from the removable storage medium (col 11, lines 1-4).

With regard to claims 35 and 44, Sakata discloses a printer (Figure 1, digital copier) comprising: means (col 5, line 7 – col 6, line 65) for printing an image according to image data; means (memory card reader V) for retrieving print control data and image data stored in a removable storage medium (laser card 220) when the medium is connected to the means for retrieving (col 20, line 50 – col 22, line 35); means for setting an operation condition of said printing means according to the output control data (col 20, line 50 – col 22, line 35); and means for controlling the printing means according to the operation condition so that the printing means can print an image according to the image data (col 20, line 50 – col 22, line 35); a sorter (sorter I, III) for sorting printed paper (col 7, lines 32-38); and means for controlling the sorter according to output control data stored in the removable storage medium (col 7, line 63 – col 8, line 7).

With regard to claim 42, Sakata discloses a digital copier wherein the steps of storing image data as compressed image data in the removable storage medium (col

Art Unit: 2622

10, lines 6-36) and reading the image data from the removable storage medium by expanding the compressed image data (col 11, lines 1-4).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 34, 41, 43-X are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakata et al. (Sakata) (US 5,105,284) in view of Nagashima (US 4,719,516).

With regard to claims 34, 41 and 43, Sakata does not clearly teach means (erasable PROM) for erasing the image data and output control data stored in the removable storage medium, after printing the image data.

Nagashima also discloses a means (erasable PROM) for erasing the image data and output control data stored in the removable storage medium, after printing the image data (which reads on the non-volatile storage being composed of an electrically erasable PROM and instructing whether an erasure of program or data is possible according to the stored content, and making it selectable) (col 3, lines 18-22; col 4, lines 29-34).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata to include means (erasable PROM) for erasing the image data and output control data stored in the removable storage medium, after

printing the image data. It would have been obvious to modify Sakata by the teaching of Nagashima so the non-volatile storage being composed of an electrically erasable PROM and instructing whether an erasure of program or data is possible according to the stored content, and making it selectable as stated in Nagashima in col 3, lines 18-22; col 4, lines 29-34.

6. Claims 36-38 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakata et al. (Sakata) (US 5,105,284) in view of Itoh (US 5,923,437).

With regard to 36, Sakata as modified differs from claim 35 in that he does not clearly teach a means for storing information of functions of the printing means and sorter into the removable storage medium so that the information can be used by an external equipment for generating output control data.

Itoh discloses an image processing apparatus wherein a means (computer equipment 901) for storing information of functions of the printing means and sorter into the removable storage medium (external storage device 902) so that the information can be used by an external equipment (external apparatus 3) for generating output control data (col 5, lines 19-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata wherein a means for storing information of functions of the printing means and sorter into the removable storage medium so that the information can be used by an external equipment for generating output control data as taught by Itoh. It would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified Sakata by the teaching of Itoh so that the output job file can be constructed with all the output modes in place at a site independent of the printing device as taught by Itoh in col 5, lines 19-64.

With regard to claims 37 and 46, Sakata discloses a printer (Figure 1, digital copier) comprising: means (col 5, line 7 – col 6, line 65) for printing an image according to image data; means (memory card reader V) for retrieving print control data and image data stored in a removable storage medium (laser card 220) when the medium is connected to the means for retrieving (col 20, line 50 – col 22, line 35); means for setting an operation condition of said printing means according to the output control data (col 20, line 50 – col 22, line 35); and means for controlling the printing means according to the operation condition so that the printing means can print an image according to the image data (col 20, line 50 – col 22, line 35).

Sakata differs from claim 37 in that he does not clearly teach a finisher for stapling printed paper; and means for controlling the finisher according to output control data stored in the removable storage medium.

Itoh discloses an image processing apparatus wherein a finisher (not shown in figures but because stapling can be performed the finisher is inherent) for stapling printed paper (col 5, lines 19-64; col 8, lines 18-22); and means (CPU {not shown}) for controlling the finisher according to output control data stored in the removable storage medium (col 5, lines 19-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata wherein a finisher for stapling printed paper;

Art Unit: 2622

and means for controlling the finisher according to output control data stored in the removable storage medium as taught by Itoh. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata by the teaching of Itoh so that the output job file can be constructed with all the output modes in place at a site independent of the printing device as taught by Itoh in col 5, lines 19-64.

With regard to claim 38, Sakata as modified differs from claim 38 in that he does not clearly teach a means for storing information of functions of the printing means and finisher into the removable storage medium so that the information can be used by an external equipment for generating output control data.

Itoh discloses an image processing apparatus wherein a means (computer equipment 901) for storing information of functions of the printing means and finisher into the removable storage medium (external storage device 902) so that the information can be used by an external equipment (external apparatus 3) for generating output control data (col 5, lines 19-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata wherein a means for storing information of functions of the printing means and finisher into the removable storage medium so that the information can be used by an external equipment for generating output control data as taught by Itoh. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata by the teaching of Itoh so that the output

job file can be constructed with all the output modes in place at a site independent of the printing device as taught by Itoh in col 5, lines 19-64.

With regard to claim 45, Sakata as modified differs from claim 45 in that he does not clearly teach a step of storing information of functions of the printer and the sorter into the removable storage medium so that the information can be used by external equipment for generating output control data.

Itoh discloses an image processing apparatus wherein a step of storing information of functions of the printer and the sorter into the removable storage medium so that the information can be used by external equipment for generating output control data (col 5, lines 19-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata wherein a step of storing information of functions of the printer and the sorter into the removable storage medium so that the information can be used by external equipment for generating output control data as taught by Itoh. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata by the teaching of Itoh so that the output job file can be constructed with all the output modes in place at a site independent of the printing device as taught by Itoh in col 5, lines 19-64.

With regard to claim 47, Sakata as modified differs from claim 47 in that he does not clearly teach a step of storing information of functions of the printer and the finisher into a removable storage medium so that the information can be used by external equipment for generating output control data.

Itoh discloses an image processing apparatus wherein a step of storing information of functions of the printer and the finisher into a removable storage medium so that the information can be used by external equipment for generating output control data (col 5, lines 19-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata wherein a step of storing information of functions of the printer and the finisher into a removable storage medium so that the information can be used by external equipment for generating output control data as taught by Itoh. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sakata by the teaching of Itoh so that the output job file can be constructed with all the output modes in place at a site independent of the printing device as taught by Itoh in col 5, lines 19-64.

Response to Arguments

7. Applicant's arguments, see Response, filed 5/4/04, with respect to the rejection(s) of claim(s) 31-47 under 102 and 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sakata et al. (Sakata) (US 5,105,284).

Art Unit: 2622

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 305-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6036 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:


(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

Twyler Lamb



July 26, 2004